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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

KSK

Mailed: June 2, 2003

Opposition No. 123,285

John O. Butler Company

v.

Dental Treatment Systems
Ltd.

Before Simms, Walters and Rogers, Administrative
Trademark Judges.

By the Board:

This case now comes before the Board for consideration of opposer's motion (filed October 22, 2002) for summary judgment on the issue of likelihood of confusion under Section 2(d) of the Trademark Act and applicant's motion (filed December 23, 2002) to amend the identification of goods in the subject application. The motions have been fully briefed.¹

BACKGROUND/PLEADINGS

Applicant has filed an application for registration of the mark GUMPIX (in typed form) for "toothbrushes,

¹ The Board has exercised its discretion and has considered opposer's reply brief filed on April 21, 2003. Trademark Rule 2.127(e).

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electric toothbrushes, toothpick holders, toothpicks, sub-gingival toothpicks, holders for interdental brushes, interproximal brushes, holders for interproximal brushes" in Class 21.²

In its notice of opposition, opposer alleges, inter alia, that "[l]ong prior to January 10, 2000...opposer adopted and used in interstate commerce the mark GUM in connection with toothbrushes and various other oral hygiene and dental products" that "[a]s a result of opposer's widespread and extensive use of the mark GUM beginning in July 1958, the mark has become widely and favorably known throughout the United States and has become recognized by the trade and public as identifying opposer's goods and distinguishing them from the goods of others" and that "applicant's mark GUMPIX, when applied to the goods of applicant, so resembles opposer's mark GUM as to be likely to cause confusion, or to cause mistake, or to deceive..."

Opposer asserted the following registrations:

G·U·M· for "toothbrushes" in class 29;³

² Application Serial No. 75/893,589 filed on January 10, 2000 and claiming a bona fide intent to use the mark in commerce.

³ Registration No. 824,430 issued on February 21, 1967, filed on July 21, 1966, Section 8 affidavit accepted, Section 15

GUM for "oral hygiene products, namely, floss threaders, floss handles and mouth mirrors" in Class 10;⁴

GUM for "interdental equipment, namely, handles, brushes, stimulator handles and tips, for home use" in class 21;⁵

GUM for "dental floss" in class 10;⁶

GUM for "toothpaste" in class 3;⁷ and GUM (typed form) for "toothbrushes" in class 21.⁸

Applicant, in its answer, denied the salient allegations of the notice of opposition.

affidavit acknowledged, renewal accepted, and claiming first use and first use in commerce in July, 1958.

⁴ Registration No. 1,826,880 issued on March 15, 1994, filed on September 18, 1992, Section 8 affidavit accepted, Section 15 affidavit acknowledged, and claiming first use and first use in commerce in September, 1992.

⁵ Registration No. 1,826,950 issued on March 15, 1994, filed on September 18, 1992, Section 8 affidavit accepted, Section 15 affidavit acknowledged, and claiming first use and first use in commerce in October, 1992.

⁶ Registration No. 1,850,157 issued on August 16, 1994, filed on September 18, 1992, Section 8 affidavit accepted, Section 15 affidavit acknowledged, and claiming first use and first use in commerce in September, 1992.

⁷ Registration No. 2,049,833 issued on April 1, 1997, filed on July 17, 1995 and claiming first use and first use in commerce in August, 1995.

⁸ Registration No. 2,199,875 issued on October 27, 1998, filed on October 15, 1998 and claiming first use and first use in commerce on August 1, 1996.

APPLICANT'S MOTION TO AMEND THE IDENTIFICATION OF GOODS

Applicant has moved to amend its identification by deleting the following goods: toothbrushes, electric toothbrushes, holders for interdental brushes, interproximal brushes, and holders for interproximal brushes. Applicant proposes that the application go forward with regard to the remaining goods: toothpick holders, toothpicks and sub-gingival toothpicks. Further, applicant "consents to judgment on the question of likelihood of confusion between opposer's mark and applicant's mark with respect to the specific goods which applicant seeks to remove from the list of goods by the proposed amendment." In regard to this consent to judgment, applicant argues that "there is no res judicata effect against the issue of likelihood of confusion for toothpicks by consenting to judgment with respect to toothbrushes" because "the issues raised with respect to use of applicant's GUMPIX mark on toothpicks...are substantially different than the issues raised with respect to use of applicant's GUMPIX mark on toothbrushes."

Opposer does not object to the amendment; however, opposer argues that "the admission of likelihood of

confusion as to the deleted goods should be res judicata as to the toothpick-related goods.”

Inasmuch as the amendment is clearly limiting in nature as required by Trademark Rule 2.71(b), it is approved. Further, applicant’s consent to judgment as to those goods is granted. With regard to the application of res judicata, the Board advises the parties that it no longer follows the policy set forth in *International Harvester Co. v. I.T.T. Corp.*, 208 USPQ 940 (TTAB 1980), see Louise E. Rooney, *Tips From The TTAB: Rule 2.133 Today*, 81 TMR 408 (1991).⁹ Moreover, this doctrine does not apply to the same proceeding where a partial judgment is rendered.

In view of the above, the Board takes up the motion for summary judgment as to applicant’s remaining goods only.

SUMMARY JUDGMENT STANDARD

Generally, summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter

⁹ In this case, we have entered judgment as to applicant’s deleted goods upon applicant’s specific request, albeit made pursuant to prior Board policy; however, the result would not be different had we disallowed the amendment and taken up the

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of law. Fed. R. Civ. P. 56(c). An issue is material when its resolution would affect the outcome of the proceeding under governing law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). However, a dispute over a fact which would not alter the Board's decision on the legal issue will not prevent entry of summary judgment. *See, for example, Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.3d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). A fact is genuinely in dispute if the evidence of record is such that a reasonable fact finder could return a verdict in favor of the nonmoving party. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987

summary judgment motion as to those goods, inasmuch as they are identical to opposer's goods.

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F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

THE PARTIES' EVIDENCE AND ARGUMENTS

Opposer has moved for summary judgment in its favor as to its Section 2(d) ground of opposition.

In support of its motion, opposer has presented evidence showing that: (1) opposer's "sales of GUM branded products since 1987 exceed \$911,000,000" (Declaration of Michael Bava, opposer's president (hereinafter "Bava") at paragraph 14); (2) opposer "has spent in excess of \$138,000,000 advertising and promoting its products under the mark GUM, and has distributed millions of catalogs for its products bearing the mark...at the rate of more than 100,000 catalogs per year" (Bava at paragraph 14); (3) opposer has continuously used its GUM mark since 1958 (Bava at

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paragraph 11); (4) opposer sells identical products to applicant's, including toothpicks (Bava at paragraph 12); (5) opposer has spent almost 45 years promoting and marketing its GUM brand products (Bava at paragraph 13); the mark used in logostyle is viewed and pronounced as the word GUM by opposer, its competitors, members of the dental profession, retailers and consumers (Bava at paragraph 14); retail drugstore chains that sell dental products place all dental and oral hygiene products in the same section of the store (Bava at paragraph 16).

Opposer's evidence on summary judgment includes the declaration of Michael Bava, opposer's president, together with the exhibits identified therein; and the declaration of Judith Grubner, opposer's outside counsel with the law firm of Michael Best & Friedrich LLC, together with the exhibits identified therein. The exhibits include opposer's 1999 catalog which shows use of its mark GUM in its various forms, including typed, for a wide range of dental products, including plastic tips to remove plaque and stimulate the gums, and opposer's packaging for toothpicks which displays the logostyle GUM mark.

In response, applicant has submitted the declaration of Diana Michelle Sobo, applicant's outside counsel with

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the law firm of Browdy and Neimark, P.L.L.C., together with the exhibits identified therein. The exhibits include the files of prior successful oppositions brought by opposer against other parties and print-outs of three third-party registrations from the U.S. Patent and Trademark Office Trademark Text and Image Database.

Opposer states that as a result of opposer's "substantial and extensive advertising and distribution of GUM branded products" its mark GUM has "become a widely known source-indicator" for its dental products among "dentists, dental professionals, dental patients and consumers." Opposer argues that it and applicant sell identical or highly related goods and that the parties' marks are highly similar. Further, opposer argues that inasmuch as the application and opposer's registrations are unrestricted as to channels of trade the analysis of likelihood of confusion cannot be limited by channels of trade. With regard to priority, opposer argues that it has used its mark GUM since 1958 on a variety of dental products and opposer has asserted several registrations predating applicant's filing date for a variety of goods.

In response, applicant argues that opposer's presentation of its case by aggregating its marks is

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"inaccurate, misleading, and inappropriate to the analysis." Applicant essentially argues that opposer is attempting to "bootstrap" its long and widespread use and registration of the stylized version of its GUM mark on toothbrushes to its other GUM marks including the typed registration. Applicant argues that opposer has used only the stylized GUM mark on toothbrushes since 1958, and the first use dates for the stylized GUM mark on opposer's other goods is 1992.¹⁰ Further, applicant argues that opposer fails to provide evidence of advertising expenditures and sales data for each of its different marks in connection with each of its goods in only the U.S. market.

Applicant argues that its toothpick products are not related to opposer's goods, "for example, toothbrushes and plaque disclosing tablets" inasmuch as they serve different purposes. Applicant provides no evidentiary support for its assertion that toothbrushes and toothpick products serve fundamentally different purposes.

In connection with opposer's assertion that its mark is widely known, applicant argues that opposer's marks

¹⁰ The "inconsistencies" in the Bava declaration noted by applicant do not affect the veracity of the declaration. The fact that a typed declaration does not display the marks in their various stylizations is mitigated by the referenced and

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are "weak when it comes to goods similar to applicant's," stating that opposer "has offered no evidence whatsoever that its [stylized GUM marks] have been widely used to identify toothpick holders or toothpicks, or sub-gingival toothpicks." Moreover, applicant argues that opposer has not discussed the "scope of use of each mark individually" but rather has aggregated its marks "in an attempt for all forms of the mark to enjoy the earliest date of use in commerce for all of opposer's goods." Further, applicant argues that opposer's typed GUM mark is weak because it is descriptive, or suggestive, of "the body part to which the benefit to the underlying product inures." In support of this argument, applicant submitted print-outs of three registrations from the U. S. Patent and Trademark Office Trademark Text and Image Database showing use of the term GUM in combination with a suffix or prefix for oral care products, to "show the meaning of the mark [GUM]."

DECISION

In determining whether there is any genuine issue of material fact relating to the legal question of likelihood of confusion, the Board must consider all of the probative facts in evidence which are relevant to the

attached copies of the registrations wherein the marks are

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factors bearing on likelihood of confusion, as identified in *In re E.I du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). As noted in the *du Pont* decision itself, various factors, from case to case, may play a dominant role. *Id.*, 476 F.2d at 1361, 177 USPQ at 567. Those factors as to

accurately depicted.

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which we have probative evidence are discussed below.¹¹

And after a careful review of the record in this case, we find that there are no genuine issues of material fact relating to these factors.

As a preliminary matter, priority is not an issue in this case in view of opposer's submission of uncontroverted evidence showing that the pleaded registrations are subsisting and owned by opposer. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Likewise we find that the evidence of these registrations is sufficient to establish opposer's standing in this case.

While the key likelihood of confusion factors in this case are the degree of similarity between opposer's

¹¹ In response to opposer's reference to prior successful oppositions against other applicants involving different goods, applicant submitted the case files to show that four of the five oppositions were not decided on the merits. Indeed, these prior oppositions have little probative value. Similarly, applicant's reference to a 1975 decision in the United States District Court for the Northern District of Illinois involving opposer and another party is likewise of little value; nearly thirty years of continuous use and subsequent registrations have occurred since that decision issued. Moreover, that decision juxtaposed one party's trademark against another party's descriptive use, unlike the present case involving trademark use by both parties; regardless of the strength of its mark, applicant claims an intent to use its proposed mark, which includes the term GUM, as a source identifier and not merely to describe its goods. Finally, applicant cannot attack the validity of opposer's registrations in the absence of a counterclaim. See *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986) (no

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various GUM marks and applicant's GUMPIX mark, and the degree of

attack on the validity of a registration pleaded by a plaintiff can be considered in the absence of a counterclaim).

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similarity between the parties' goods as recited in their respective registrations and application and as attested to in opposer's declaration, we have also considered other *du Pont* factors in making our determination.

The evidence of record clearly establishes the lack of a genuine issue of material fact as to the strength of opposer's logostyle GUM marks in block lettering with raised periods or dashes for use in connection with a wide variety of dental hygiene products. Even discounting the advertising and sales data, which runs into the hundreds of millions,¹² and the aggregation of the use dates among the products and the different versions of the mark, the first logo version of opposer's mark has been used on toothbrushes for 45 years and subsequent stylizations of the mark have been used on other dental hygiene products for between 7 and 10 years. Throughout this time the literal portion of the mark, the term GUM, remained the same. This use culminated in a registration for the term GUM in typed form. However, even without a showing of fame or strength, the parties' marks and goods are

¹² There is some ambiguity in opposer's evidence as to what portion of these figures is attributed to U.S. sales and advertising versus sales and advertising abroad. However, inasmuch as the figures are so high, even assuming a portion

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sufficiently similar to support a finding of likelihood of confusion.

Turning now to the marks, we find that when these marks are considered in their entirety, they are substantially similar in sound, appearance, and commercial impression. The only difference between the marks is the stylization in six of opposer's marks and the suffix PIX in applicant's mark, and as to one of opposer's registered marks, the only difference is the suffix PIX in applicant's mark. The stylization in the mark in six of the registrations does not work to distinguish opposer's marks from applicant's mark. Opposer's declaration that consumers view and pronounce its logo mark as the word GUM and not by its individual letters stands unrebutted and is self evident. Moreover, applicant's mark is in typed form and the rights associated with a mark in typed form reside in the wording and not in any particular display. Therefore, we must consider use in all normal forms of display, which could include the same typeface as opposer's. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

dedicated to foreign sales and advertising, these figures are still significant.

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The only literal difference between the marks is the suffix PIX which is, at best, highly suggestive of applicant's goods, toothpicks. Therefore, the addition of this descriptive/suggestive suffix does not sufficiently serve to distinguish applicant's proposed mark from opposer's GUM marks. Marks may be confusingly similar in appearance notwithstanding the addition, deletion or substitution of letters. See *Weiss Associates, Inc. v. HRL Associates*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). In fact, it may serve to heighten the potential for confusion inasmuch as consumers could view this as an extension of opposer's GUM-brand product line. See *Plus Products v. Pharmavite Pharm. Corp.*, 221 USPQ 256 (TTAB 1984).

As to the goods offered by each party, opposer's identified goods are competitive with and highly related to applicant's goods. Opposer has presented evidence of use of the mark GUM (in various formats) for, inter alia, an interdental cleaner, which is a plastic tip used to remove plaque and stimulate the gums (Exhs. P and U at 18), and toothpicks (Exh. V). Such goods, if not identical, are highly related to applicant's subgingival toothpicks. Even without this evidence of common law use, opposer has registrations for a variety of dental

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products including toothbrushes, flossers, stimulators, orthodontic wax and mouth mirrors. Goods such as flossers and stimulators also serve a similar purpose, i.e., to remove plaque and stimulate gums, rendering them competitive with and/or complementary to applicant's goods. *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Opposer's registrations for a wide variety of dental hygiene products is a factor to be weighed in determining the relatedness of the goods. See *Con-Stan Industries, Inc. v. Villaamil Tobacco Products, Inc.*, 157 USPQ 397 (TTAB 1968). Under the circumstances of this case, this factor weighs heavily in opposer's favor.

Regarding the channels of trade, both the involved application and opposer's pleaded registrations are unrestricted. Thus, the Board must presume that the goods are marketed or will be marketed in all the normal channels of trade for the identified goods and to all the usual classes of purchasers of such goods. See *Kangol Ltd. v. KangaROOS U.S.A.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed Cir. 1992). Further, opposer has submitted an un rebutted declaration that opposer's and applicant's goods are displayed in the same section of retail stores that carry their respective goods. In addition, there is

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no genuine issue as to the relatively inexpensive nature of these products.

Inasmuch as applicant has not yet begun use of its mark, the fact that there has been no actual confusion is not a basis upon which to weigh this factor in applicant's favor. There has been no opportunity for actual confusion. Hence, this factor is neutral. Moreover, it is unnecessary to show actual confusion in establishing likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983).

In summary, considering the wide and extensive use of opposer's marks, the substantial similarity of the marks, the relatedness of the goods, and the presumptively similar trade channels and purchasers we find that there are no genuine issues of material fact and that confusion would be likely to result from contemporaneous use of the parties' marks.

As to the scope of protection to be accorded to opposer's various marks, individually and combined, applicant has only presented three third-party registrations to be weighed against forty-five years of continuous use of the logostyle GUM mark on related goods, namely, toothbrushes, between seven and ten years

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use of the logostyle GUM mark on a variety of related dental hygiene products, and at least five years use of the typed GUM mark on toothbrushes. At a minimum, opposer's marks, whether considered individually or as a group, used with its dental hygiene products, are sufficiently strong source indicators to bar applicant's registration of the proposed mark GUMPIX for toothpicks, toothpick holders and subgingival toothpicks. Even if we considered the plaintiff's marks to be entitled to a limited scope of protection, they still are entitled to protection from registration of a very similar mark that would be likely to cause confusion.

In view of the above, opposer's motion for summary judgment on the issue of likelihood of confusion under Section 2(d) of the Trademark Act is granted. Accordingly, judgment is hereby entered against applicant, the opposition is sustained, and registration to applicant is refused.

* * *